

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**REQUEST FOR FILING CONTINUATION/DIVISIONAL  
APPLICATION UNDER 37 C.F.R. § 1.53(b)**

**Mail Stop PATENT APPLICATION**

**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

Customer Number **2 1 8 3 9**

Sir:

This is a request for filing a ☒ continuation ☐ divisional application under 37 C.F.R. § 1.53(b) of the following pending application, by the following named inventor(s):

Application No. 09/132,231 Filed: August 11, 1998

Title: METHOD FOR PRODUCING NOVEL DNA SEQUENCE WITH BIOLOGICAL ACTIVITY


Inventor(s): Marshall S. HORWITZ and Lawrence A. LOEB

- ☒ The entire disclosure of the prior application from which a copy of the oath or declaration is supplied herewith is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
- ☐ This application is being filed by less than all the inventors named in the prior application. In accordance with 37 C.F.R. § 1.63(d)(2), the Commissioner is requested to delete the name(s) of the following person or persons who are not inventors of the invention being claimed in this application.

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- ☐ This application is being filed by more than all the inventors named in the prior application. In accordance with 37 C.F.R. § 1.63(d)(5), a new oath or declaration is enclosed, and the Commissioner is requested to add the name(s) of the following person or persons who are inventors of the invention being claimed in this application.

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-  Applicant(s) suggests Figure \_\_\_\_ for inclusion on the front page of the patent application publication and patent.

- ☒ Applicant(s) requests that the published application include the following assignment information:  
University of Washington, Seattle, Washington

[illegible]

1-15-04<sup>JO</sup>

A3

- Page 2 of 3

☐ The certified copy of the priority application

☐ is enclosed.

☐ was filed on \_\_\_\_\_ in prior Application No. \_\_\_\_\_, filed on \_\_\_\_\_, and acknowledged by the Examiner on \_\_\_\_\_ in Paper No. \_\_\_\_\_.

☐ has not yet been filed.

12. ☐ A preliminary amendment is enclosed.

13. ☐ An Information Disclosure Statement is enclosed.

14. ☒ A General Authorization for Payment of Fees and Petitions for Extensions of Time is enclosed.

15. ☐ Also enclosed is \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

16. ☒ The power of attorney in the prior application is to R. Danny Huntington

a. ☐ The power appears in the original papers in the prior application.

b. ☒ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c. ☒ Recognize as Associate Attorney Sharon E. Crane, Ph.D.

d. ☒ Address all future communications to: (May only be completed by applicant, or attorney or agent of record.)

Burns, Doane, Swecker & Mathis, L.L.P.  
Customer Number 2 1 8 3 9  
P.O. Box 1404  
Alexandria, Virginia 22313-1404

1/15/04  
Date

By: Sharon E. Crane  
Sharon E. Crane, Ph.D.  
Registration No. 36,113

Address of signator:

Burns, Doane, Swecker & Mathis, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

☐ inventor(s)  
☐ assignee of complete interest  
☒ attorney or agent of record  
☐ filed under 37 C.F.R. § 1.34(a)



Patent  
Attorney Docket No. 032425-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Marshall S. Horwitz et al.

Group Art Unit: 1635

Application No.: 10/757,590

Examiner: John S. Brusca

Filing Date: January 15, 2004

Confirmation No.: 5121

Title: METHOD FOR PRODUCING NOVEL DNA SEQUENCE WITH BIOLOGICAL ACTIVITY

TRANSMITTAL LETTER FOR MISSING PARTS OF APPLICATION

MAIL STOP MISSING PARTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In complete response to the Notice to File Missing Parts of Application filed Under 37 C.F.R. § 1.53(b) dated October 18, 2004, enclosed please find:

- ☐ a Combined Declaration and Power of Attorney signed by the inventor(s);
  - ☐ Note that the inventor/inventors identified on the concurrently filed Combined Declaration and Power of Attorney is/are different than listed on the application filing papers.
- ☐ an Application Data Sheet;
- ☐ the surcharge of ☐ \$65.00 (2051) ☐ \$130.00 (1051) as set forth in 37 C.F.R. § 1.16(e);
- ☐ a Request for Refund;
- ☐ a Petition for Extension of Time;
- ☐ a verified English translation of the Application, and the \$130.00 (1053) fee as set forth in 37 C.F.R. § 1.17(k);
- ☐ an Assignment document and a separate check for the \$40.00 (8021) Assignment recordation fee;
- ☐ drawings for publication;
- ☒ IDS;
- ☐ a certified copy of the priority document;
- ☐ copy of Notice to File Missing Parts of Nonprovisional Application; and
- ☒ other copy of Notice of Incomplete Nonprovisional Application; Response to Notice of Incomplete Nonprovisional Application and/or Petition for Filing Date Pursuant to 37 C.F.R. 1.57(a)(3); Amendment; Declaration of Sharon E. Crane, Ph.D.

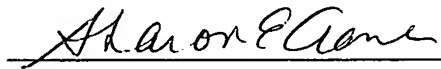
- ☐ A check in the amount of \_\_\_\_\_ for the fee due for missing parts is enclosed.
- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800 for the fee due for missing parts.
- ☐ Charge \_\_\_\_\_ to credit card. Form PTO-2038 is attached.
- ☐ Small entity status is hereby claimed.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

By   
Sharon E. Crane, Ph.D.  
Registration No. 36,113

Date: December 15, 2004



Patent  
Attorney's Docket No. 032425-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	<b>MAIL STOP MISSING PARTS</b>
Marshall S. Horwitz et al.	)	
Application No.: 10/757,590	)	Group Art Unit: 1635
Filed: January 15, 2004	)	Examiner: John S. Brusca
For: METHOD FOR PRODUCING NOVEL DNA	)	Confirmation No.: 5121
SEQUENCES WITH BIOLOGICAL	)	
ACTIVITY	)	

**RESPONSE TO NOTICE OF INCOMPLETE  
NONPROVISIONAL APPLICATION AND/OR PETITION  
FOR FILING DATE PURSUANT TO 37 C.F.R. 1.57(a)(3)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants submit that the "Notice of Incomplete Nonprovisional Application" mailed October 18, 2004, has issued in error. Applicants incorporated by reference "The entire disclosure of the prior application." *See Exhibit 1, "Request for filing Continuation/Divisional Application Under 37 C.F.R. § 1.53(b)." Therefore, Applicants incorporated the figures of the prior application. See Exhibit 2, M.P.E.P. § 608.01(p) I.A. 1.*

Based on the foregoing, Applicants respectfully request that the instant application be given a **January 15, 2004** filing date.

In addition, copies of original Figures 1-6 of parent application Serial No. 09/132,231 are attached as Exhibit 3.

An Amendment adding Figures 1-6 of the parent application is submitted herewith pursuant to 37 C.F.R. 1.57(a). If the Office deems that a fee and petition is

owed by the submission of this paper, it is requested that this paper be treated as a Petition and/or a fee be charged to the below-mentioned Deposit Account.

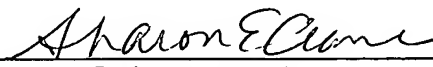
In the event that there are any questions relating to this Response, or the application in general, it would be greatly appreciated if the undersigned attorney was contacted concerning such questions so that prosecution of this application may be expedited.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 15, 2004

By   
Sharon E. Crane, Ph.D.  
Registration No. 36,113

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
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 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/757,590	01/15/2004	Dipak K. Dube	032425-001

CONFIRMATION NO. 5121

21839

BURNS DOANE SWECKER &amp; MATHIS L L P

POST OFFICE BOX 1404

ALEXANDRIA, VA 22313-1404

FORMALITIES LETTER



\*OC000000014121518\*

Date Mailed: 10/18/2004

## NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

## FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above-identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items must be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)). Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

- The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented." *Applicant should reconsider whether the drawings are necessary under 35 U.S.C. 113 (first sentence).*
- This application clearly fails to comply with the requirements of 37 CFR. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:



- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice MUST be returned with the reply.*

Y.G.

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE